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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,713	12/11/2001	Reiner Fischer	Bayer 9914.2-KGB	7412

27384 7590 05/09/2003

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NEW YORK, NY 10017

EXAMINER

KIFLE, BRUCK

ART UNIT	PAPER NUMBER
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1624

3

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

Office Action Summary

Application No.

10/014,713

Applicant(s)

Fischer et al.

Examiner

Bruck Kifle, Ph.D.

Art Unit

1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 11, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 12, and 14 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 12, and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/875,872.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1 6) ☐ Other:

Art Unit: 1624

Election/Restriction

Claims 1-5, 12 and 14 are generic to a plurality of disclosed patentably distinct species comprising compounds of formula (I). Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

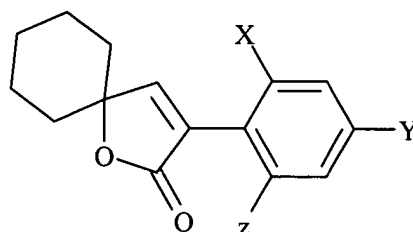
During a telephone conversation with Mr. Kurt Briscoe on May 7, 2003 a provisional election was made with traverse to prosecute the invention of Example 1-2-a-1 on page 122 of the specification. Affirmation of this election must be made by applicant in replying to this Office action.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The elected compound was not found in the search and the search was expanded to embrace compounds wherein "Het" is formula (2) and A and B represent a cyclohexyl group.

Art Unit: 1624

The search embraced the formula:



Subject matter not falling under this formula is withdrawn from consideration.

Improper Markush Rejection

Claims 1-5 and 12 and 14 are rejected as being drawn to an improper Markush group. The claims lack unity of invention because the variable “Het” on formula (I) is defined in such a way that it keeps changing the core of the compound that determines the classification. In order to have unity of invention the compounds must have “a community of chemical or physical characteristics” which justify their inclusion in a common group, and that such inclusion is not repugnant to principles of scientific classification” In re JONES (CCPA) 74 USPQ 149 (see footnote 2). In the instant case, however, by changing these values, several patentably distinct and independent compounds are claimed. The structural formula (I) has only the benzene ring as common. Compounds embraced by formula (I) are so diverse in nature that a prior art anticipating a claim with respect to one member under 35 USC 102 would not render obvious the same claim under 35 USC 103. This is evidentiary of patentably distinct and independent inventions.

Regarding claim 5, note that compounds, corresponding compositions, a method of use and a process of making that are of the same scope are considered to form a single inventive

Art Unit: 1624

concept under PCT Rule 13.1, 37 CFR 1.475(d). The processes of claim 5 are not so linked as to form a single inventive concept. These processes are so diverse in scope that a prior art anticipating one process 35 USC 102 would not render obvious another process of the same claim under 35 USC 103.

Limiting the claims to the elected subject matter and election of a single process in claim 5 overcomes this rejection.

Claim Rejections - 35 USC § 112

Claims 1-5 and 12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i) In claim 1, in the definition of “X” at line 8, the phrase “or in each case optionally substituted phenyl, phenoxy, phenylthio, benzyloxy or benzylthio” is indefinite because one cannot say what the substituents are.
- ii) In claim 1, in the definitions of R¹-R⁷ the phrase “cycloalkyl which can be interrupted by at least one heteroatom” is indefinite because one cannot say which atom is intended. The phrase “optionally substituted” is also indefinite for the reasons stated above.
- iii) It is suggested to rewrite claim 12 as a proper composition claim if that is applicants intend, such as, “A pesticidal or herbicidal composition comprising a compound of formula I according to claim 1 along with a pesticidal or herbicidal acceptable carrier.”

Art Unit: 1624

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 12 and 14 are rejected under 35 U.S.C. 102(a) as being anticipated by Fischer et al. (US 5,262,383). The claims read on numerous compounds of the reference (see table 8, compound Ia-5 to Ia-12; Ia-17-Ia-20; etc.).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer et al. (US 5,262,383). The reference teaches structurally similar compounds which are embraced by applicants' claims as herbicides and pesticides (see col.1, formula (I) and definitions of the variables). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the


Art Unit: 1624

reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the references as a whole. It has been held that a prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. *In re Susi*, 440 F.2d 442, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in *Merck & Co. v. Biocraft Laboratories*, 847 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.

The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

May 8, 2003


Bruck Kifle
Primary Examiner
Art Unit 1624